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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/647,518 | 11/30/2000 | Martin Friede | B45139 | 8200 |

20462 7590 10/21/2002

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EXAMINER

CEPERLEY, MARY

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| ART UNIT | PAPER NUMBER |
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1641

DATE MAILED: 10/21/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.



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| APPLICATION NO./ CONTROL NO. | FILING DATE | FIRST NAMED INVENTOR / PATENT IN REEXAMINATION | ATTORNEY DOCKET NO. |
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| EXAMINER |
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| ART UNIT | PAPER |
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Commissioner of Patents and Trademarks

See the attached letter.

Mary (Molly) E. Ceperley
Primary Examiner
Art Unit: 1641

Art Unit: 1641

(1) The reply filed on July 30, 2002 is **not fully responsive** to the prior Office Action because of the following omission(s) or matter(s):

a) The proposed claim amendments and claim cancellations are inconsistent with earlier pending claims, earlier filed amendments and earlier filed claim cancellations.

i) The preliminary amendment of Nov. 30, 2000 canceled claims 25-29, 31, and 36. Inconsistently, the amendment of July 30, 2002 requests that claim 29 be cancelled. There are also amendments made to cancelled claims 25-28 (not entered).

ii) There is a proposal in the July 30, 2002 response to "amend" claims 38 and 39 (not entered); however, claims 38 and 39 were never presented earlier in any form.

iii) There is a request in the July 30, 2002 response to cancel claims 40 and 41. No claims 40 and 41 have ever been present in this application.

b) Newly submitted claim 1 and claims dependent therefrom are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons. The adjuvant and vaccine compositions of original claims 1 and 22 constitute **product** claims while a method of raising an immune response in an individual as recited in amended claim 1 constitutes a **method of use** claim. The two sets of claims are distinct in accordance with MPEP 806.05(h) for the reason that the adjuvant composition of original claim 1 could be used in an alternative method of use, for example as a surfactant. Additionally, the two sets of claims require different patentability considerations: a patentability determination for the composition requires a determination of the novelty and unobviousness of the composition component(s) **independent of any method of use** while a patentability determination for a method of use requires a determination of the novelty and unobviousness of the **use** of the composition independent of whether or not the composition components are known entities.

Art Unit: 1641

Since applicants have received an action on the merits for the originally presented invention, this invention has been ***constructively elected by original presentation for prosecution on the merits***. Accordingly, all claims drawn to a method of use as recited in amended claim 1 will be withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.


2) Since the above-mentioned reply appears to be *bona fide*, applicants are given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

3) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary E. (Molly) Ceperley whose telephone number is (703) 308-4239. The examiner can normally be reached from 8 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le, can be reached at (703) 305-3399. The fax phone number for responses to be filed BEFORE final rejection is (703) 872-9306. The fax phone number for responses to be filed AFTER final rejection is (703) 872-9307.

Questions which are NOT RELATED TO THE EXAMINATION ON THE MERITS, should be directed to **TC 1600 CUSTOMER SERVICE** at **(703) 308-0198**. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

October 18, 2002


Mary E. (Molly) Ceperley
Primary Examiner
Art Unit 1641